

REMARKS

Applicant thanks the Examiner for the very thorough consideration given the present application.

Claims 1, 3-6 and 8-23 are now present in this application. Claims 1, 6 and 18 are independent.

Claims 1, 6 and 18 have been amended and claims 2 and 7 canceled. No new matter is involved. Reconsideration of this application, as amended, is respectfully requested.

CLAIM AMENDMENTS

Applicant has amended claim 1 to include the subject matter of claim 2, which has been canceled. Claim 6 has been amended to include the subject matter of claim 7, which has been canceled. Claim 18 has been amended to include the subject matter of claim 2 or 7.

REASONS FOR ENTRY OF THIS AMENDMENT

At the outset, it is respectfully requested that this Amendment be entered into the Official File in view of the fact that the amendments to the claims automatically place the application in condition for allowance. The Amendments do not require further consideration and/or search because they merely add the subject matter of dependent claims into independent

claims.

In the alternative, if the Examiner does not agree that this application is in condition for allowance, it is respectfully requested that this Amendment be entered for the purpose of appeal. This Amendment reduces the issues on appeal by canceling dependent claims 2 and 7 and incorporating the features thereof into the three independent claims.

REJECTIONS UNDER 35 U.S.C. §103

Claims 1-23 stand rejected under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent 5,764,341 to Fujieda et al. (hereinafter, "Fujieda") in view of Applicant's Admitted Prior Art (APA). This rejection is respectfully traversed.

A complete discussion of the Examiner's rejection is set forth in the Office Action, and is not being repeated here.

In rejecting claims under 35 USC §103, it is incumbent on the examiner to establish a factual basis to support the legal conclusion of obviousness. See, In re Fine, 837 F.2d 1071, 1073, 5 USPQ2d 1596, 1598 (Fed. Cir. 1988); and In re GPAC, Inc., 57 F.3d 1573, 1582, 35 USPQ2d 1116, 1123 (Fed. Cir. 1995). In so doing, the Examiner is expected to make the factual determinations set forth in Graham v. John Deere Co., 383 U.S. 1, 17, 148 USPQ 459, 467 (1966), and to provide a reason why one of

ordinary skill in the pertinent art would have been led to modify the prior art or to combine prior art references to arrive at the claimed invention. Such reason must stem from some teaching, suggestion or implication in the prior art as a whole or knowledge generally available to one having ordinary skill in the art. Uniroyal Inc. v. F-Wiley Corp., 837 F.2d 1044, 1051, 5 USPQ2d 1434, 1438 (Fed. Cir. 1988), cert. denied, 488 U.S. 825 (1988); Ashland Oil, Inc. v. Delta Resins & Refractories, Inc., 776 F.2d 281, 293, 227 USPQ 657, 664 (Fed. Cir. 1985), cert. denied, 475 U.S. 1017 (1986); ACS Hospital Systems, Inc. v. Montefiore Hospital, 732 F.2d 1572, 1577, 221 USPQ 929, 933 (Fed. Cir. 1984). These showings by the examiner are an essential part of complying with the burden of presenting a *prima facie* case of obviousness. Note, In re Oetiker, 977 F.2d 1443, 1445, 24 USPQ2d 1443, 1444 (Fed. Cir. 1992). The mere fact that the prior art may be modified in the manner suggested by the examiner does not make the modification obvious unless the prior art suggested the desirability of the modification. In re Fritch, 972 F.2d 1260, 1266, 23 USPQ2d 1780, 1783-84 (Fed. Cir. 1992). To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be suggested or taught by the prior art. In re Royka, 490 F.2d 981, 180 USPQ 580 (CCPA 1970). All words in a claim must be considered in judging the patentability of that claim against

the prior art. In re Wilson, 424 F.2d 1382, 1385, 165 USPQ 494, 496 (CCPA 1970).

A showing of a suggestion, teaching, or motivation to combine the prior art references is an "essential evidentiary component of an obviousness holding." C.R. Bard, Inc. v. M3 Sys. Inc., 157 F.3d 1340, 1352, 48 USPQ2d 1225, 1232(Fed. Cir. 1998). This showing must be clear and particular, and broad conclusory statements about the teaching of multiple references, standing alone, are not "evidence." See In re Dembiczak, 175 F.3d 994 at 1000, 50 USPQ2d 1614 at 1617 (Fed. Cir. 1999).

In this Application, the only admitted "prior art" is stated on page 4, line 8, to be the iris recognition system schematically illustrated in Figure 1.

Fig. 2 is not admitted prior art. Fig. 2 is labeled "conventional art" but is not admitted prior art. In order for something to be considered admitted prior art, the admission must be clear, unmistakable and unequivocal. See, in this regard, Fleming v. Giesa (BdPatApp&Int) 13 USPQ2d 1052 (7/17/1989); Harner et al. v. Barron et al., 215 USPQ 743 (Comr Pats 1981), Suh v. Hoefle (BdPatApp&Int) 23 USPQ2d 1321 (4/30/1991); Issidorides v. Ley (BdPatApp&Int) 4 USPQ2d 1854 (4/2/1985); and Ex parte The Successor In Interest Of Robert S. McGaughey (BdPatApp&Int) 6 USPQ2d 1334 (3/4/1988).

Thus, it is impermissible for the Office Action to use anything but Fig. 1 as admitted prior art.

Independent claim 1 recites an optical axis adjustment unit to align optical axes of the image recognition unit and guidance unit, and claim 18 recites an optical axis alignment unit to align the optical axes of the image recognition unit and guidance unit.

Fujieda, the base reference used in the rejection, discloses three separate optical axes. These optical axes are shown in Fig. 5 and discussed in cols. 6 and 7 of Fujieda. These three optical axes are labeled "L", "M" and "N." As clearly shown in Fig. 5, none of these three optical axes is aligned with the other optical axes. Fujieda does not align the optical axes that form these three target images. Instead, Fujieda aligns three target images.

In response to this argument, the Office Action disagrees with Applicant's conclusion, stating that, "Fujieda, in col. 3, lines 40-45 states with the help of figure 1 numerical 4 for the alignment unit to align the apparatus to the eye, i.e., the optical axis in order to take the image."

Applicant respectfully disagrees for a number of reasons.

In the first place, col. 3, lines 40-45 describe Fig. 1, which does not disclose the three separate, non-aligned optical axes "L", "M" and "N," or in any way discuss these three optical axes or their relationship to each other.

In the second place, in order to take an image of the eye E, only TV camera 24 needs to be lined up with the eye E, which it is, along axis "L" connecting the TV camera 24 and eye E. The TV camera 24 does not take an image of the light source 37, for example, nor does it take an image of light source 31, nor are the optical axes "M" and/or "N" aligned with optical axis "L."

Moreover, independent claims 1 and 18 recite aligning the optical axes of the image recognition and guidance units.

Thus, the base reference does not disclose or suggest this aspect of the claimed invention.

Moreover, Fujieda does not disclose or suggest "an image recognition unit to recognize an image of an iris passed through the guidance unit," as recited in independent claim 1, or "an image recognition unit including an optical system having a plurality of lenses for gathering light and a pickup device for imaging an iris of the eye," as recited in claim 6.

Fujieda does not disclose imaging an iris of the eye or recognizing an image of an iris, as recited.

The Office Action does not even address the claimed feature of aligning the optical axes of an image recognition unit and a guidance unit. Therefore, the rejection fails to make out a *prima facie* case of obviousness of the claimed invention recited in independent claims 1 and 18, and

dependent claims 2-5, which depend from claim 1, and of claims 19-22, which depend from claim 18.

The Office Action then turns to the prior art system of Fig. 1 and concludes that it would be obvious to “simply use the well known features of the iris recognition system in the Fujieda’s system of alignment and measuring of an eye as it is conventionally use [d] in the art (as can be seen by the instant specification – see page 1, last two lines). And this modification provides an apparatus that will do the iris recognition more precisely because the apparatus will align the eye with the optical axis.”

This conclusion is improper, however, because it completely fails to provide any objective evidence of proper motivation for one of ordinary skill in the art to modify Fujieda in view of the Figure 1 prior art. As pointed out above, a showing of a suggestion, teaching, or motivation to combine the prior art references is an “essential evidentiary component of an obviousness holding.” Moreover, this showing additionally fails to present clear and particular objective evidence of the desirability of modifying Fujieda in view of the Fig. 1 admitted prior art.

Furthermore, broad conclusory statements about the teaching of different eye measuring devices, standing alone, is not “evidence” of proper motivation. See In re Dembiczak, cited above.

Applicant respectfully submits that the Office Action is engaging in impermissible hindsight reconstruction of the claimed invention using appellant's structure as a template and selecting elements from references to fill the page. The references themselves must provide some teaching whereby the appellant's combination would have been obvious. In re Gorman, 911 F.2d 982, 986, 18 USPQ2d 1885, 1888 (Fed. Cir, 1991). That is, something in the prior art as a whole must suggest the desirability, and thus obviousness, of making the combination. See, In re Beattie, 974 F.2d 1309, 1312, 24 USPQ2d 1040, 1042 (Fed. Cir. 1992); Lindemann Maschinenfabrik GMBH v. American Hoist and Derrick Co., 730 F.2d 1452, 1462, 221 USPQ 481, 488 (Fed. Cir. 1984).

Here, the fact that both Fujieda's ophthalmic apparatus and iris recognition systems are known is not evidence that it would be obvious to modify one in view of the other absent evidence of motivation to combine both references and modify one in view of the other to achieve the claimed invention. Cf., In re Dembiczak, cited above.

Moreover, the references themselves differ substantially, and the Office Action never addresses these differences, as it is supposed to in determining whether the invention as a whole is obvious.

As noted above, Fujieda does not align different optical axes. Nor does the admitted prior art.

In response to these arguments directed to the failure of the Office Action to provide objective factual evidence of proper motivation to combine these references, the Office Action asserts that “[I]n this case, to have the eye adjusting for the purpose of image of the iris in order to recognize the iris is a common knowledge in the art (as said in the instant specification page 1, last 2 lines).”

This argument begs the question of whether it would be obvious to completely redesign Fujieda, which really does not disclose iris recognition, but is really nothing more than “an objective eye-refractive power measuring apparatus or the like” (col. 1, lines 14-15), to make its three separate optical axes become aligned with one another, in view of the fact that the allegedly admitted prior art of Fig. 1 is an iris recognition device, not a refractive power measuring apparatus.

Moreover, the only disclosure of aligning different optical axes is found in Applicant’s disclosure. It is impermissible to use Applicant’s disclosure against Applicant. That is known as hindsight reconstruction of Applicant’s invention based solely on Applicant’s disclosure.

Moreover, because neither reference includes this alignment of different optical axes feature, even if these two prior art references were properly combined (which they are not for reasons stated above), they would

not result in, or render obvious, the claimed invention recited in claims 1-5 and 18-23.

Additionally, amended independent claims 1 and 18 further positively recite "wherein the guidance unit has a guidance region printed at a center of a front surface thereof so that a person can locate his or her eye at the guidance unit."

This feature is not found in any of the applied art and, thus, is neither disclosed by or obvious in view of the applied art. Moreover, with this feature, a person can locate his or her eye at the guidance unit and easily adjust an optical axis in case that the optical axes do not match each other. The claimed invention differs drastically from Fujieda.

With respect to claims 6-17, neither Fujieda nor the admitted prior art of Fig. 1, discloses an optical axis adjustment unit for adjusting any of its three disclosed optical axes. In Fujieda, the optical axes "L", "M" and "N" are not adjusted. Only the images formed along those axes are adjusted. And, in the admitted prior art of Fig. 1, none of the optical axes of the different units are discussed or adjusted.

Thus, even if these two prior art references were properly combined (which they are not for reasons stated above), they would not result in, or render obvious, the invention recited in claims 6-17.

Further, with respect to claim 7, the measuring window 5a of Fujieda is not disclosed as printed, as recited.

Further, with respect to claims 11-14, the Office Action relies on Fig. 2 of Fujieda, which is only a joystick, and is not a fixing frame that supports the image recognition unit from below, as recited, or a horizontal movement frame installed on a top surface of the fixing frame, as recited. Nor does Fig. 2 of Fujieda disclose an adjustment guide with "another hole formed as one edge thereof," as recited. This feature is not even addressed in this rejection.

Further, with respect to claims 15-17, number 4 in Fig. 2 of Fujieda is not a "lifting guide bar extended from the hole of the frame." Element 4 is a joystick. Additionally, the Office Action does not indicate where the claimed "vent holes" are found in Fig. 2, and Applicant has not found them in Fig. 2. Nor is it clear from the rejection what is "an screw as it rotates." Presumably this refers to joystick 4, but Fig. 2 shows no threads on joystick 4. Nor is the stopper recited in claim 16 addressed in the Office Action. Also, the assertion that an elastic member is obviously provided to joystick 4, is pure speculation unsupported by fact. As is well settled, a rejection based on Section 103 must rest on a factual basis, with the facts being interpreted without hindsight reconstruction of the invention from the prior art. In making this evaluation, the examiner has the initial duty of

supplying the factual basis for the rejection he advances. An Examiner may not, because of doubts that the invention is patentable, resort to speculation, unfounded assumptions or hindsight reconstruction to supply deficiencies in the factual basis, See, In re Warner, 379 F.2d 1011, 1017, 154 USPQ 173, 178 (CCPA 1967), cert. denied, 389 U.S. 1057 (1968).

The conclusion that claims 1-5 and 18-23 are broader than claims 6-10 and 6-17 and, thus, are rejected for the same reasons as claims 6-10 and 6-17 overlooks the differences between the inventions recited in claims 1-5, 6-17 and 18-23, pointed out above.

This cursory rejection of claims 1-5 and 18-23 is additionally improper for its failure to delineate exactly how claims 1-5 and 18-23 are broader in all aspects than claims 6-10 and 6-17. As such, it is improper because it denies Applicant its right to fundamental procedural and substantive due process in violation of the Administrative Procedures Act, and must be withdrawn. See in this regard, In re Zurko, 119 S.Ct. 1816, 50 USPQ2d 1930 (1999), and In re Gartside, 53 USPQ2d 1769 (Fed. Cir. 2000).

Lastly, as pointed out above, amended independent claim 6 further positively recites "wherein the guidance unit has a guidance region printed at a center of a front surface thereof so that a person can locate his or her eye at the guidance unit."

This feature is not disclosed in any applied art and, therefore, is neither disclosed by or obvious in view of the applied art. Moreover, with this feature, a person can locate his or her eye at the guidance unit and easily adjust an optical axis in case that the optical axes do not match each other. The claimed invention differs drastically from Fujieda.

A fair, balanced view of the rejection of claims 1-23 under 35 USC 103(a) as unpatentable over Fujieda in view of Applicant's admitted prior art reveals that violates Applicant's fundamental substantive and procedural due process under the Administrative Procedures Act, fails to present any objective evidence to provide one of ordinary skill in the art proper motivation to combine these references as suggested, fails to take into consideration the differences between the references which would teach against combining these two references, and even if the references were properly combined, which they are not for reasons stated above, the reference combination would not result in, or render obvious, the claimed invention.

Accordingly, withdrawal of the rejection and allowance of claims 1-23 is respectfully requested.

ADDITIONAL CITED REFERENCES

Since the remaining references cited by the Examiner have not been utilized to reject the claims, but have merely been cited to show the state of the art, no comment need be made with respect thereto.

CONCLUSION

All of the stated grounds of rejection have been properly traversed, accommodated, or rendered moot. Applicants therefore respectfully request that the Examiner reconsider all presently outstanding rejections and that they be withdrawn. It is believed that a full and complete response has been made to the outstanding Office Action, and as such, the present application is in condition for allowance.

If the Examiner believes, for any reason, that personal communication will expedite prosecution of this application, the Examiner is invited to telephone Robert J. Webster, Registration No. 46,472, at (703) 205-8000, in the Washington, D.C. area.

Prompt and favorable consideration of this Amendment is respectfully requested.

If necessary, the Commissioner is hereby authorized in this, concurrent, and future replies, to charge payment or credit any overpayment

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to Deposit Account No. 02-2448 for any additional fees required under 37
C.F.R. §§1.16 or 1.17; particularly, extension of time fees.

Respectfully submitted,

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